

REMARKS

The outstanding Office action, mailed May 18, 2005, was made final. Concurrently filed with this Amendment in Response to Office Action are a Request for Continued Examination (RCE) and a Petition for Extension of Time with payments for required fees.

By this submission previously pending claims 22, 23 and 53 are amended. No new matter is introduced by the now submitted amendments. Claims 54 and 55 are identified by this submission as being "withdrawn" in accordance with the conclusion reported in the final action at section 3 that these two claims are "directed to a non-elected invention."

Withdrawal of the finality of the outstanding action and entry and consideration of now submitted claim amendments are in order under regulations provided for a filed RCE (37 CFR §1.114).

It is requested in view of the submitted amendments and following discussions that all rejections reported in the outstanding Office and advisory actions be reconsidered and not repeated in any further action issued for this application.

Advisory Action

It is asserted in the advisory action that this application is not in condition for allowance because:

I) It has been held that to be entitled to weight in method claims, the recited-structure limitations therein must affect the method in a manipulative sense, and not to amount to mere claiming of a use of a particular structure. *Ex Parte Pfeiffer*, 1962 C.D. 408 (1961)."

II) "Tabib-Azar reference discloses claimed method steps."

III) "Bordoni et al. ('A Microwave Scanning Surface Harmonic Microscope Using A Re-Entrant Resonator Cavity' 1995) discloses near-field interaction between an ultra-sharp tip and sample under investigation."

Each of these assertions as to why the application is not in condition for allowance is addressed below.

I&II) Before addressing bases asserted in these two sections for the rejections, the now submitted claim amendments are considered.

Claims 22-30, 43 and 53 currently stand rejected under 35 USC §103(a). Of these claims both claims 22 and 53 are independent, and all of the other claims are dependent from independent claim 22. If independent claims 22 and 53 are non-obvious then all of their dependent claims also are non-obvious as has been addressed in earlier filings submitted for prosecution of this application. Amendments here are submitted for independent claims 22 and 53, and a conforming amendment is submitted for claim 23.

The preambles of claims 22 and 53 respectively recite methods “for measuring electrical impedance of a sample using a microwave cavity having a pointed tip” and “using a scanning evanescent microwave cavity probe...having a pointed tip.” Now both of these claims are amended to recite process steps of “positioning said sample outside said microwave cavity and adjacent but not in contact with said pointed tip.” Support for such recitations includes application Figure 1a and associated disclosures. Further, these process step recitations are supported by prior pending claim recitations such as “measuring interaction between said tip and sample without contacting said sample with said tip.” (Claims 22 and 53)

With these understandings as to pending claim recitations, the asserted rejection basis that “recited-structure limitations...must affect the method in a manipulative sense, and not...amount to mere claiming of a use of a particular structure. *Ex Parte Pfeiffer*, 1962 C.D. 408 (1961)” is addressed. The cited decision for this proposition is also reported at 135 USPQ 31 and is a December 20, 1961 Board of Appeals decision that sustained claim rejections for method claims as including structural limitations for a container as well as method steps for filing, dropping, and opening the container. Specifically, the Board stated:

As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here. (1962 C.D. at 411)

In the case of the pending claims, manipulative steps are recited as is explicitly clarified by the submitted amendments, which include at least: “positioning said sample outside said microwave cavity and adjacent but not in contact with said pointed tip”; “measuring

interaction between said pointed tip and said sample”; and, “deriving electrical impedance from said microwave cavity probe pointed tip-sample interaction” or “determining electrical properties of said sample from said microwave cavity probe pointed tip-sample interaction measurement.” These all are process step recitations and not mere structural limitation recitations without manipulative recited limitations. As such, it is submitted that the portion of the holding in *In re Pfeiffer* premised from method claims reciting mere structural limitations is misapplied here because of at least the submitted clarifying amendments as to recited manipulative steps. These manipulative steps it is submitted support distinctions over cited references.

The pending claims of this application recite more than a “mere...use of a particular structure” as the Board asserted in *In re Pfeiffer*. Irrespective of that fact is the further fact of where the law has progressed since that decision. Specifically, seven years after the *In re Pfeiffer* decision, the Court of Customs and Patent Appeals ruled in *In re Tarczy-Hornoch*, 397 F.2d856, 158 USPQ 141 (CCPA 1986) that “a process claim, otherwise patentable, should not be rejected merely because the application of which it is part discloses apparatus which will inherently carry out the recited steps.” (MPEP §2173.05(v)) Thus, it is submitted that *In re Pfeiffer* premised rejections that in any way disregard process step manipulations of structures to distinguish over cited references are overcome.

With the above discussed understandings of the clarified method step recited limitations and the current law for these matters, it is submitted that the Tabib-Azar¹ reference does not disclose or suggest the pending claimed method steps. As is discussed in the current prosecution record for this application, the Tabib-Azar disclosed subject matter does not disclose or suggest the method steps recited in the now pending claims.

III) It is submitted that the Bordoni et al., “A Microwave Scanning Harmonic Microscope Using A Re-Entrant Resonant Cavity”, Meas. Sci. Technol. 6 (1995) pp. 1208-1214 (hereinafter Bordoni et al.) newly cited reference also does not disclose or suggest method steps as recited in the pending claims.

Bordoni et al. disclose using a tip within a “re-entrant resonator cavity” and also positioning a sample within a “re-entrant resonator cavity” (see Bordoni et al. Figures 3 and

¹ Tabib-Azar, et al., “Non-Destructive Characterization of Materials by Evanescent Microwave,” Meas. Sci. Technology, Vol. 4, 1993, pp. 583-590.

4) to study sample properties. As such Bordoni et al. fails to disclose or suggest method steps recited in the pending claims for this application, e.g., at least "positioning said sample outside said microwave cavity...."

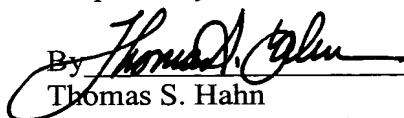
Thus, no cited reference or proper combination of references disclose or suggest pending claim recited subject matter to support 35 USC §103 rejections.

CONCLUSION

It now is submitted that the amendments introduced and the above discussions overcome all rejections reported in the final and advisory actions. Therefore, it further is submitted that the pending claims are in condition for allowance and a notice of the same is requested. Should the Examiner have any question, request or suggestion, he is invited to contact the undersigned attorney at the telephone number indicated below.

Dated: *October 18, 2005*

Respectfully submitted,

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